

RESPONSE AND REMARKS

The recent telephone interview on November 10, 2004 with Examiner Cosimano is gratefully acknowledged with appreciation. A summary of the substance of the interview is included in the substance of this Response and Remarks as required by the rules. As of the date of the filing of this Response and Remarks, a copy of the Interview Summary has not yet been received.

Claims 1 - 11 of the present application have been amended, as indicated above. Claims 12 - 30 have been cancelled. New Claims 31 - 40 have been added.

The Examiner organized the Office action by numbered topics. In this Response, citations to the Office action indicate the relevant topic number.

SPECIFICATION AND DRAWINGS

In the Office action, the Examiner objected to the specification regarding element 3026 of FIG. 36C. It is respectfully submitted that the specification mentions the "NO" path from inquiry element 3026 at lines 20 through 22, page 57 of the substitute specification: "(If the rate input violates carrier business rules 3026, continue to next carrier 3027); 3) Determine the zone ID from CarrierZone table for the given origin/destination postal codes 3028 . . ." Element 3028, FIG. 36D, is the element to which processing proceeds if the answer to Inquiry element 3026 is "No".

In the Office action, the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1163, 1168, 1169, 1172, and 1175 of FIG. 39B. It is respectfully submitted that the referenced "No" paths are implied in the substitute specification as follows: the 1163 "No" path is implied on page 62, line 27; the 1168 "No" path is implied on page 63, line 8; the 1169 "No" path is implied on page 63, line 16; the 1172 "No" path is implied on page 63, line 26; and the 1175 "No" path is implied on page 64, line 8.

In the Office action, the Examiner objected to the specification regarding the "No" answer logic flow path to the inquiries of elements 1180, 1184, 1187, and 1190 of FIG. 39C. It is respectfully submitted that the referenced "No" paths

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are implied in the specification as follows: the 1180 "No" path is implied on page 64, line 17; the 1184 "No" path is implied on page 64, line 27; the 1187 "No" path is implied on page 65, line 9; and the 1190 "No" path is implied on page 65, line 20.

TERMINAL DISCLAIMERS

In the Office action, the Examiner provisionally rejected Claims 1-30 under the judicially created doctrine of double patenting over the claims of Application Nos.: 09/680,649, 09/680,654, 09/684,014, 09/684,861, 09/684,865, 09/684,866, 09/684,869, 09/685,077, and 09/685,078.

Terminal Disclaimers, one executed by Stamps.com Inc., and the other executed by iShip Inc., to Obviate a Provisional Double Patenting Rejection Over Pending Second Applications were previously submitted under 37 CFR 1.321. The Examiner objected to the submission, requiring evidence of chain of title.

In response to the Examiner's rejection, statements under 37 CFR 3.73(b), one executed by Stamps.com Inc., and the other executed by iShip Inc., are submitted herewith providing evidence of chain of title.

SECTION 102

In the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. § 102(b) as being anticipated by a PR Newswire release by TanData, reflecting a date of July 21, 1997 (referred to herein as "TanData") or Thiel, U.S. Patent No. 5,699,258 ("Thiel").

The Examiner's rejection of the Claims has been carefully considered.

Reconsideration of the application, as reflected in the substitute specification previously submitted, and as reflected in the claims, as amended herewith, is respectfully requested in view of the following responsive remarks.

RESPONSIVE REMARKS REGARDING SECTION 102 REJECTIONS

It is respectfully submitted that neither the TanData nor Thiel references can be presumed to be enabling references with respect to the claimed subject matter of the present application, as amended. Notably, although the claims of a

United States patent carry a presumption of validity under 35 U.S.C. §282, and therefore a presumption of enablement under 35 U.S.C. §112, there is no such presumption as to unclaimed subject matter. The claims of *Thiel* are not directed to the subject matter of the present application. Therefore, there is no presumption of enablement as to unclaimed disclosure of *Thiel*.

Further ``[t]o anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.'' *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558 (Fed. Cir. 1996). It is respectfully submitted that, for the following reasons, the independent claims of the present application, as amended, are not anticipated by either the *TanData* and *Thiel* references, or by any other reference of record.

With respect to independent Claims 1, 9, 31 and 39, it is respectfully submitted that neither of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest a centralized computer system, or a method of configuring a plurality of server computer devices, for managing shipping comprising ". . .concurrent remote access by [a] plurality of users via a communications network . . ." .

With respect to independent Claims 6 and 7, it is respectfully submitted that neither of the cited references, whether considered alone or in combination with any other reference of record, disclose, teach or suggest a centralized computer system for managing shipping "wherein a first server computer is programmed to communicate with each of the plurality of users over multiple telecommunications connections over the global communications network *at one time . . .*"

The *TanData* reference discloses:

Using a web browser on a computer in Chicago, a connection will be made with a web server running at the Oracle headquarters in Northern California. Using an Oracle web server application cartridge written by TanData, the web server will make a connection to TanData RateServers running on machines in Tulsa, Oklahoma. The resulting rates, picked by the shopper in the form of "fastest" or "least expensive" options, will return to the browser in Chicago.

It is respectfully submitted that the TanData mention of the "... web browser on a computer in Chicago [making a connection] with a web server running . . . in Northern California . . . mak[ing] a connection to . . . RateServers running on machines in . . . Oklahoma . . ." does not disclose, teach or suggest "...concurrent remote access by [a] plurality of users via a communications network ..." as claimed, in one way or another, by each of independent Claims 1, 9, 31 and 39, as amended, of the present application.

Further, it is respectfully submitted that the TanData mention of the "... web browser on a computer in Chicago [making a connection] with a web server running . . . in Northern California . . . mak[ing] a connection to . . . RateServers running on machines in . . . Oklahoma . . ." does not disclose, teach or suggest a centralized computer system for managing shipping "wherein a first server computer is programmed to communicate with each of the plurality of users over multiple telecommunications connections over the communications network at one time . . ." as claimed by independent Claim 6.

In the Office action, the Examiner stated that "Thiel ('258) discloses a network based shipping system that comprises properly programmed central computer/server and client shipping systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers." Office Action, Topic Number 8.1.3, page 6.

It is respectfully submitted that, although Thiel does mention a communications network (Thiel, col. 3, lines 9-20), the communications network mentioned in Thiel is merely a transmission means for downloading postage rate tables into memory of a postal franking device. See, e.g., Thiel, col. 2, lines 56-65.

Further, it is respectfully submitted that any particular Thiel postal franking device is only locally available to a particular shipping user. See, e.g., Thiel, col. 8, line 39 – col. 9, line 10; see also, e.g., Thiel, col. 9, lines 1-10. A Thiel postal franking device rates a shipment based on postage rate tables that have been downloaded and stored in the memory of that particular device. See, e.g., Thiel, col. 8, line 39 – col. 9, line 10. In Thiel, the weight and type of mail is input by a

single user using an input means to the particular postal franking device. See, e.g., *Thiel*, col. 9, lines 1-10.

As compared to the locally accessible postal franking device of *Thiel* for use by a single particular shipping user, the centralized computer system for shipping management of the invention claimed, in one way or another, by each of independent Claims 1, 31 and 39 (as amended) and the at least a first server computer device of independent Claim 9, are available for concurrent remote access by a plurality of users over a communications network. As opposed to merely downloading rate tables using a network from some computer to one of the *Thiel* franking devices, the system of the claimed invention is concurrently remotely accessible by many users via a communications network, such as the Internet, and is capable of providing shipping management functionality to all of the system's many users.

Further, neither the *TanData* reference nor *Thiel*, or for that matter, any other reference of record, anticipate, teach or suggest, programming, as claimed, for example, in currently amended Claim 1, each server computer device of a plurality of server computer devices to perform at least one particular shipping management function ". . . wherein at least a second server computer device . . . is programmed to perform . . . rating each respective request by each respective user of the plurality of users to ship a respective parcel."

CONCLUSION

For all of the foregoing reasons, it is therefore respectfully submitted that independent Claims 1, 6, 7, 9, 31 and 39, of the present application, as amended, are patentable over the cited references.

Further, because for all of the foregoing reasons, independent Claims 1, 6, 7, 9, 31 and 39, of the present application, as amended, are patentable over the cited references, it is respectfully submitted that dependent Claims 2-5, 8, and 10-11, as amended, and new dependent Claims 32-38, are therefore also patentable over the cited references.

Applicant respectfully submits that the invention disclosed and claimed in the present application, as amended, is not fairly taught by any of the

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references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the application as reflected in the previously submitted substitute specification and in the amended claims.

Respectfully submitted,

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